

### **Remarks**

Claims 1 - 3, 6, and 7, are pending. Favorable reconsideration is respectfully solicited.

Applicants continue to traverse the restriction requirement, as its basis is in error. The Examiner states that pyrogenic silicas direct from the burner are different from pyrogenic silica which is stored. As can be seen from the specification on page 4, silicas which come directly from the burner are hydrophilic as are also pyrogenic silicas which have been stored or commercially packaged. Whether direct from the burner or after storage, both are hydrophilic silicas. Claim 1 has been amended to restrict the metal oxide to silica. Claims 4 and 5 have been cancelled as redundant. Claim 7 has been amended to be dependent upon claim 1, thus incorporating all the limitations of claim 1. Per MPEP 821.04, the claims, being product and process of manufacture claims, should be rejoined. Claims 8 - 14 have been cancelled. Rejoinder is thus solicited.

Claim 7 has been rejected under 35 U.S.C. § 112 ¶1. The claimed silicas are characterized not only by the % carbon but also by other parameters. These other parameters do not allow for 0% carbon, and thus "less than 0.1% carbon" must be taken in conjunction with the other parameter requirements, and does not read on 0%. However, to expedite prosecution, Applicants have amended claim 7 to recite "more than 0%", per the Examiner's thoughtful suggestion. Withdrawal of the §112¶1 rejection is solicited.

Claim 7 has also been rejected under 35 U.S.C. § 112¶1 for reciting a methanol number less than 30. The Office states that silica with a methanol number of "0" is no longer even partly hydrophobic. This is incorrect. As can be seen in Table 1 on page 22, three subject invention examples have a methanol number of 0. However, these silicas are still partly hydrophobic, as can be seen from both their %C content and their contact angle  $\theta$ . Silylation always renders a silica less hydrophilic, and either partly hydrophobic as in the



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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22045 7590 06/29/2007 BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			EXAMINER TSOY, ELENA	
			ART UNIT 1762	PAPER NUMBER Dm: 7-29-07
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Notice of Non-Compliant  
Amendment (37 CFR 1.121)**

Application No.

10/738,543

Applicant(s)

GOTTSCHALK-GAUDIG ET  
AL.

Examiner

Elena Tsoy

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 15 June 2007 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: See Continuation Sheet.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):  
\_\_\_\_\_

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

**Failure to timely respond** to this notice will result in:

**Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

**Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

(571)-272-1429

Legal Instruments Examiner (LIE), if applicable

Telephone No.

ELENA TSOY  
PRIMARY EXAMINER

*E Tsoy*

Continuation of 4(e) Other: Applicants' amendment has changed statutory subject matter. Amendment to claim 7 converted the product claim into a composition claim that is independent or distinct from the invention originally claimed. Since applicant has received an action on the merits for the originally presented invention, this invention will be constructively elected by original presentation for prosecution on the merits. Accordingly, claims 7, 10, 12 and 14 will be withdrawn from consideration as originally presented non-elected composition claims 8-14.